

REMARKS

Claims 1-24 are pending in the application.

Rejections under 35 U.S.C. §§ 102(a) and 103(a)

The Examiner has rejected claims 1-4, 9, 10-20 and 22-24 under 35 U.S.C. § 102(a) as allegedly anticipated by Deshpande et al., “Biphasic catalysis for a selective oxo-Mannich tandem synthesis of methacrolein,” *Journal of Molecular Catalysis A: Chemical*, 211(1-2):49-53 (2004) (“Deshpande”). The Examiner alleges that Deshpande discloses a biphasic (water/toluene) approach for the tandem synthesis of methacrolein from ethylene via hydroformylation and subsequent aldol reaction with formaldehyde, wherein the hydroformylation of ethylene is conducted in the presence of a rhodium catalyst, and the subsequent aldol reaction is conducted in the presence of a basic catalyst (preferably diethylamine/acetic acid).

The Examiner has rejected claims 5-8 and 21 under 35 U.S.C. § 103(a) as allegedly obvious over Deshpande. Deshpande does not disclose a rhodium catalyst precursor or a reaction pressure of 50 to 450 psi. The Examiner alleges that, in the absence of unexpected results, it is immaterial whether a catalyst precursor that forms an active catalyst *in situ* or an active catalyst is used in the reaction, as a person of ordinary skill would reasonably expect the hydroformylation reaction to occur in either case. Furthermore, the Examiner alleges that the lowest pressure disclosed in Deshpande is 547 psi, but that absent a showing of unexpected results, a person of ordinary skill would experiment with reaction conditions to obtain optimal production of the end product.

The Examiner has indicated in a telephone call to Applicants' representative on September 30, 2005 that, since an applicant's disclosure of his own work within the year before the application filing date cannot be used against him as prior art, Deshpande can be overcome if the Applicants file an *In re Katz* declaration. *In re Katz*, 687 F.2d 450 (C.C.P.A. 1982). The declaration must set forth the nature of the work performed on the project by A.N. Mahajan, who is listed as a co-author of Deshpande, but is not a co-inventor of the instant application.

The Applicants' representative is still in the process of obtaining the information necessary to prepare the declaration. The Applicant is a branch of the government of India and the correspondent of the undersigned is also located in India. Applicants' attorney believes the reference can be overcome.

Dated: May 1, 2006

Respectfully submitted,

By Adda C. Gogoris
Adda C. Gogoris

Registration No.: 29,714
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant